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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/942,453	JESSOP ET AL.
	Examiner	Art Unit	
	GREG POLLOCK	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 March 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-19,23,34,45 and 47* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-13, 15-19, 23, 34, 45, and 47* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to claims filed 03/13/2009 and Applicant's request for

reconsideration of application 09/942453 filed 03/13/2009.

The amendment contains original claims 2-4, 6-12, and 15-19.

The amendment contains previously presented claims 5, 13, 23, and 45.

The amendment contains amended claims 1 and 34.

The amendment contains new claim 47.

Claims 14, 20-22, 24-33, 35-44, and 46 have been canceled.

As such, claims 1-13, 15-19, 23, 34, 45, and 47 have been examined with this

office action.

Claim Objections

2.   The claims are objected to because of the following minor informalities:

a.   **Claims 1 and 47** contain the use of the word **"therebetween"**. The examiner

can find no such word in Webster's II New Riverside Dictionary (Copyright

1996, Houghton Mufflin Company) or by use an Internet search using

OneLook Dictionary Search (http://www.onelook.com/). The phrase should be

replaced by equivalent proper English.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 47 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 47 contain the claim limits **"determining at least one pattern between said first and said second corporate entity information types based on the comparison; and constructing a financial product based on said selected and displayed information types and said determined at least one pattern".** The disclosure of the present application does not identify how these method steps are performed as to enable that one skilled in the art to produce and use the disclosed apparatus. Specifically, page 11, ¶3 indicates that a critical path (pattern) is identified based on any desired criteria. The remainder of page 11 to page 15 indicated the various criteria which can be used for identification of the critical path (pattern), but fail to provide the details of <u>how</u> one skilled in the art would perform the pattern identification. Further, the construction of the financial product <u>from the pattern</u> is not clearly described. Pages 17 and 18 of the present application describe constructing financial products, however, there is no connection made between the identified pattern (critical path) and the construction of a financial product. Further still, it is unclear that these are

method steps performed by software and are not human mental steps. If these

claim limits are considered a core/central part of what the applicant invented,

then it must be clear that the method steps are performed by a specific machine

(i.e. software, stored on a medium, read by a processor, executing the method

steps). The invention, therefore, is inoperable as disclosed.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Regarding **claim 45**, the phrase "may" renders the claim indefinite because it is

unclear whether the limitation(s) following the phrase are part of the claimed

invention.

6.   **Claims** 1-13, 15-19, 23, 34, 45, and 47 are rejected under 35 U.S.C. 112,

second paragraph, as being incomplete for omitting essential structural

cooperative relationships of elements, such omission amounting to a gap

between the necessary structural connections. See MPEP § 2172.01. The

omitted structural cooperative relationships are: the structural elements

responsible for performing action within each of the method limits. Claims 1-13,

15-19, 23, 34, 45, and 47 list method steps but do not recite what structural

components perform each of the method steps. For example, claim 1 recites the

claim limitation "constructing a financial product based on said selected and

displayed information types and said determined at least one pattern". It is

unclear from the claims what structural component is performing this claim limit,

or it the limit is performed instead by human means. To correct this deficiency, it must be clear which disclosed component is performing each and every method step. Further, if the method step is performed by software, it must be made clear that the software resides on a physical media and when read by a processor executes the method steps (all of which requires support in the specification). Note that in doing so, the 35 USC § 101 rejection requiring method steps to be performed on another statutory class also is rectified as long as it is clear that the underlying structure is statutory.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   **Claims 1-13, 15-19, 23, 34, 45, and 47** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward the statutory category of a method (process), however based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a statutory § 101 process must (1) be tied to a particular machine or apparatus or (2) physically transform underlying subject matter (such as an article or materials) to a different state or thing. (i.e. "machine-or transformation test"). If neither of these requirements is met by the claim, method is not a patent eligible process under § 101 and is rejected as being directed toward non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field -of-use limitation in the preamble is insufficient to render an otherwise ineligible method claim patent-eligible. The machine or transformation must impose meaningful limits on the method claims scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Therefore, reciting a specific machine or a particular transformation of a specific article is an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

As example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus to qualify as a § 101 statutory process, the claim should positively recite the other statutory class

(thing or product) to which it is tied, for example by identifying the apparatus that

accomplishes the method steps, or positively recite the subject matter being

transformed, for example by identifying the material being changed to a different

state. (Diamond v. Diehr, 450 US 175, 184 (1981); Parker V. Flook, 437 US

584,588 n.9 (1978); gottschalk v. Benson, 409 US 63, 70 (1972); Cochrane v

Deener, 94 US 780, 787-88 (1876)). Applicant is also directed to MPEP §

2173.05p, providing guidance with respect to reciting a product and process in

the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the

effect of limitations within the preamble of a claim.

In reference to claims, the claims do not positively recite the other statutory

class (thing or product) to which it is tied, by identifying the apparatus that

accomplishes the method steps. For example, claim 1 has been amended to

include nominal recitations of a "processor-implemented" method. However the

remaining limits of claim 1 do not recite what structural apparatus is performing

the method steps. Therefore, it is unclear what is performing these method steps

and as such it is broadly interpreted to encompass all means by which the claim

limit can be performed (including a purely mental step performed by a human).

To resolve this deficiency, it must be made clear what underlying apparatus is

used to perform each recited method step, particularly those that are considered

a core/central part of what the applicant invented. Additionally, merely stating the

underlying apparatus in the preamble is not sufficient. Further, if the method step

is performed by software, it must be made clear that the software resides on a

physical media and when read by a processor executes the method steps (all of

which requires support in the specification). It is recommended that the claim be

amended to clarify which method steps are performed by automatically by code

and which required human decisions or action.

Claim Interpretation - Intended Use or Intended Results

9.   In determining patentability of an invention over the prior art, all claim limitations

have been considered and interpreted as broadly as their terms reasonably

allow. See MPEP § 2111.

> Although the claims are interpreted in light of the specification, limitations
> from the specification are not read into the claims. See In re Van Geuns, 988
> F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993).
> Applicant always has the opportunity to amend the claims during prosecution,
> and broad interpretation by the examiner reduces the possibility that the
> claim, once issued, will be interpreted more broadly than is justified. In re
> Pruter, 415 F.2d 1393, 1404-05, 162 USPQ 541,550-51 (CCPA 1969). See
> MPEP § 2111.

All claim limitations have been considered. Additionally, all words in the claims

have been considered in judging the patentability of the claims against the prior

art. The following language is interpreted as not further limiting the scope of the

claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result,

but the expression does not result in a manipulative difference in the steps of the

claim. Language in a system claim that states only the intended use or intended

result, but does not result in a structural difference between the claimed

invention and the prior art. In other words, if the prior art structure is capable of

performing the intended use, then it meets the claim. For example **claims 1 and**

47 contain *inter alia* the phrases "**providing an alteration mechanism to**

dynamically change an information type" and "**displaying … in separate**

display panels in the graphical user interface to facilitate a comparison".

Both claims state the intended use of the **alteration mechanism** and **the**

graphical user interface. Such claim limits do not structurally distinguish

themselves from any prior art which shows a computer connected to a network

(or Internet), which is capable of running software.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

> **Examiner's note**: Examiner has pointed out particular references contained in the prior art of
> record in the body of this action for the convenience of the Applicant. Although the specified
> citations are representative of the teachings in the art and are applied to the specific limitations
> within the individual claim, other passages and figures may apply. Applicant, in preparing the
> response, should consider fully the **entire** reference as potentially teaching all or part of the
> claimed invention, as well as the content of the passage as taught by the prior art or disclosed by
> the Examiner.

11.   Claims 1-13, 15-19, 23, 34, 45, and 47 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Guheen et al. (U.S. Patent No. 6721713) in view of

Feibush et al. (PGPub Document No. 20020158918) in further view of Rebane

(U.S. Patent No. 6078904).

As per claim 1, Guheen et al. teaches **a processor-implemented method, comprising:**
selecting a first corporate entity information type that defines a first corporate entity ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);
selecting a second corporate entity information type that defines a second corporate entity ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);
selecting a corporate entity relationship information type that defines a relationship between said first and second corporate entity information types ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14]);
displaying said corporate entity identity and said corporate entity relationship information types in a graphical user interface view with predetermined indicia, the indicia graphically providing an indication of a connection between said first and second corporate entity information types ([Figures 1, 8, 10, 11, 16, 18, 23B, 27A-F, 29A] [columns 1-2] [columns 7-14]);
providing an alteration mechanism to dynamically change an information type, chosen from the group comprising corporate entity, corporate entity relationship, selection, grouping, arrangement and view type to be displayed in said graphical user interface view ([Figures 21C, 27A-F, 29A] [columns 1-2] [columns 7-14] [column 29]. Here the examiner notes that, although the entire claim limit is shown in the prior art, it is only required that "an alteration mechanism" be disclosed since the remainder of the claim limit "to dynamically change an information type, chosen from the group comprising corporate entity, corporate entity relationship, selection, grouping, arrangement and view type to be displayed in said graphical user interface view" is a statement of intended use.).

Guheen et al. discloses comparing of the strengths and weaknesses of each individual entity ([column 11]). However, Guheen et al. does not explicitly disclose **graphically providing an indication of a strength of the relationship or dynamically changing, using said alteration mechanism, a displayed information type to a newly chosen information type; displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types.**

However, Feibush et al. discloses **graphically providing an indication of a strength of the relationship and dynamically changing, using said alteration mechanism, a displayed information type to a newly chosen information type** ([Figures 5-7] [pages 1-4]); **displaying, simultaneously, said**

newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types ([Figures 4-7] [¶30-33] Here the examiner notes that, although the entire claim limit is shown in the prior art, it is only required that "displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface" be disclosed since the remainder of the claim limit "to facilitate a comparison regarding said first corporate entity and said second corporate entity information types" is a statement of intended use.).

It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of comparison displays based on running scenarios for analysis, comparison and patterns regarding relationships between entities as disclosed by Feibush et al. with the method of pictorially displaying alliances among entities as disclosed by Guheen et al.. The motivation would be to use commonly known techniques in the field of computer technology to provide multiple views within one screen to provide a means of making side-by- side visual comparisons.

Guheen et al. and Feibush et al. do not teach **determining at least one pattern between said first and said second corporate entity information types based on the comparison; and constructing a financial product based on said selected and displayed information types and said determined at least one pattern.**

Rebane teaches *inter alia* that an account management module provides a user interface to one or more online investment systems, such as a brokerage house to access and update an investor's account. The account management module retrieves and displays securities data, corporate financials, market performance data and other research information. The account management module also provides for individual trades in the investor's accounts, and transfers the list of current buy/sell order to the investor's investment account for execution. The communications interface gateway provides an interface to external databases containing securities data, such as corporate financial data, industry performance, securities price and performance data, investment advisor opinions and consensus ratings, and the like, including, in some versions, more comprehensive portfolio management services without the portfolio analysis and optimization functions as provided by the present invention, as commonly available from brokerage houses, investment firms, and other sources. [column 11]. The investor specifies predicted future performance data for each investment asset. The future performance data may be the alpha, beta, sigma, R2, and cross correlations related to the Efficient Market Hypothesis approach or derived

from any other predictive theory, including estimates that may by available in the securities database, information from investment advisors, or inputs which just reflect the investor's own assessments of the future performance of the investments. Regardless of the Market Hypothesis used, the short list maker module computes and updates a covariance matrix for the list [column 12, lines 39-59] (applicant's **determining at least one pattern between said first and said second corporate entity information types based on the comparison.** Also see [Figure 10] [columns 17-18, Section 5.4.4 Correlation Matrix]). Rebane further teach **constructing a financial product based on said selected and displayed information types and said determined at least one pattern** ([Title] [Abstract] [column 12, lines 28-46]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Rebane with that of Guheen et al. and Feibush et al. to achieve the claimed invention. Guheen et al. provides a system and method for identifying alliances among a plurality of business entities in components of a network framework [Abstract], which can be combined with Feibush et al. to depict a more detailed flow diagram showing data representing objects, events, and correlations that are classified to produce a taxonomy. Each object being a tangible entity that occupies a physical location or region in space and has a state with multiple attributes associated therewith, where each object can stand alone without any link to other entities in the correlation graph. [¶19]. The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that the invention Rebane could retrieve and use such data as part of its user interface when constructing and optimizing an investment portfolio. Therefore, since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Indeed, any number of prior art references can be combined with Guheen et al. and Feibush et al. to construct a portfolio from the performance data (applicant's patterns and/or critical path) to accomplish the claimed invention. The examiner has listed a few other examples of prior art made of record and not relied upon in the Conclusion section of this office action which could also be used to generate a portfolio using data acquired from the interface of the combined inventions of Guheen et al. and Feibush et al.

As per claims 2-13, the rejection of claim 1 has been addressed.
Guheen et al. teaches **predetermined corporate entity information chosen from the group comprising corporate entities and corporate information; the group comprising buyer-seller relationships, customer-supplier relationships, company-client relationships, parent company-subsidiary relationships, ownership relationships, resource sharing relationships, joint ventures, political/business relationships, competitor relationships, value chain relationships, horizontal and vertical relationships; selection**

and grouping information chosen from the group comprising stocks,
bonds, financial instruments, sectors, industry segments, SIC codes, and
product lines; arrangement information chosen from the group comprising
column, row, grid, map, free-form, and structured; view type information
chosen from the group comprising fundamental information, market risk
information and performance information ([Figures 1, 8, 10, 11, 14, 16, 17,
18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14]).

As per claims 15-19, the rejection of claim 1 has been addressed.
Guheen et al. teaches corporate entity and corporate relationship indicia are
chosen from the group comprising graphic, audio, video; graphic and
corporate entity relationship indicia chosen from the group comprising
color, pattern and shape ([Figure 1, 11, 16, 22, 27A- F, 94] [columns 1-2]
[columns 7-14]).

As per claim 23, the rejection of claim 1 has been addressed.
Guheen et al. teaches that alteration mechanism is chosen from the group
comprising pointing device input, keyboard input and voice input ([column
23]).

As per claim 34, the rejection of claim 1 has been addressed.
Guheen et al. and Feibush et al. do not teach a method wherein the financial
product is chosen from the group comprising market baskets of financial
instruments, structured products, financial indices and mutual funds.

Rebane teaches a method wherein the financial product is chosen from the
group comprising market baskets of financial instruments, structured
products, financial indices and mutual funds ([column 8, lines 6-23]).

It would have been obvious to one of ordinary skill in the art at the time of the
invention to have combined the invention of Rebane with that of Guheen et al.
and Feibush et al. to achieve the claimed invention. Guheen et al. provides a
system and method for identifying alliances among a plurality of business entities
in components of a network framework [Abstract], which can be combined with
Feibush et al. to depict a more detailed flow diagram showing data representing
objects, events, and correlations that are classified to produce a taxonomy. Each
object being a tangible entity that occupies a physical location or region in space
and has a state with multiple attributes associated therewith, where each object
can stand alone without any link to other entities in the correlation graph. [¶19].
The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that
the invention Rebane could retrieve and use such data as part of its user
interface when constructing and optimizing an investment portfolio. Therefore,

since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 45, the rejection of claim 1 has been addressed.
Guheen et al. teaches **providing another information type, chosen from the group of government entities, government information, financial entities, financial information, industry information, industry segment information, sector information, index information, personal entities and personal information, that may be displayed in said graphical user interface view, selected by said alteration mechanism, and related to the other information types by said indicia** ([Figures 1, 8, 10, 11, 14, 16, 17, 18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14] [column 23]).

As per claim 47, All of the limits of Claim 47 have been previously addressed in Claims 1-13, and is therefore rejected using the same prior art and rationale.

Response to Arguments

12.   Applicant's arguments with respect to claims 1-13, 15-19, 23, 34, 45, and 47

have been considered but are either moot in view of the new ground(s) of

rejection or are not persuasive.

13.   <u>APPLICANT ARGUES (page 10-15):</u> Applicants argues that the prior art of

record do not teach "determining at least one pattern between said first and said

second corporate entity information types based on the comparison; and

constructing a financial product based on said selected and displayed information

types and said determined at least one pattern".

14.   EXAMINER'S RESPONSE: This argument is moot in view of the new ground(s)

of rejection. The rejection above serves as the examiners response to the

applicant's arguments.

15.   APPLICANT ARGUES (pages 11-12): The applicant argues that Guheen et al.

(U.S. Patent No. 6721713) and Feibush et al. (PGPub Document No.

20020158918) combined do not teach "displaying, simultaneously, said newly

chosen information type associated with said first corporate entity information

type and said second corporate entity information type, each in separate display

panels in the graphical user interface to facilitate a comparison regarding said

first corporate entity and said second corporate entity information types".

16.   EXAMINER'S RESPONSE: The examiner respectfully disagrees with the

argument presented. First, Feibush et al. (PGPub Document No. 20020158918)

does disclose the use of sub-graphs with an entire correlation graph ([Figure 4]

[¶30, lines 1-7]). As shown in Figure 4, they all appear simultaneously. Second,

applicant has argued that Feibush et al. (PGPub Document No. 20020158918)

specifically discloses, in the same section (paragraphs 30-31) that users can

review the correlation graphs to compare the results and examine the overlap of

events, the emergence of new correlations, etc. as the results are reviewed over

a period of time taking into account changes amongst the input relationship data

over time. Therefore, Feibush et al. (PGPub Document No. 20020158918)

provides for the evaluation of patterns of the data such as changes in the

correlations, the overlap of events, etc. along a time continuum. Guheen et al.

(U.S. Patent No. 6721713) provides the first and second corporate entity

information as the basis of information in a correlation graph.

17.   APPLICANT ARGUES (pages 14-15): Applicants submit that the pending

rejection has provided no indication of the level of ordinary skill in the art. MPEP

§ 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly

or implicitly in view of the prior art applied, an indication of the level of ordinary

skill." The pending rejection repeatedly refers to, "one of ordinary skill in the art,"

(e.g., pages 3, 4 and 6, September 15, 2008 Final Office Action) but has

provided no indication or discussion of which art is described or the level of

ordinary skill associated therewith. The rejection's reference to "the art" is overly

general and, consequently, does not provide a specific indication of the level of

ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states,

"The importance of resolving the level of ordinary skill in the art lies in the

necessity of maintaining objectivity in the obviousness inquiry." Applicants also

submit that impermissible hindsight has been applied in asserting obviousness of

the various claim elements without providing an indication of the level of ordinary

skill. As such, Applicants respectfully request that, if the Examiner maintains this

rejection, the Examiner discuss the level of ordinary skill in the art at the time of

the invention and clarify how the claimed subject matter would have allegedly

been obvious to one possessing that level of skill without applying impermissible hindsight.

18.   <u>EXAMINER'S RESPONSE</u>: In response to applicant's argument regarding "one ordinary skill in the art", In accordance with statute and case law, the MPEP instructs examiners that "[t]he question of obviousness must be resolved on the basis of [the Graham] factual determinations." MPEP 2141(II). With regard to the issue of ordinary skill, MPEP 2141(II) continues: "In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done." The Manual also states at MPEP 2141(II)(C), "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill."

The question regarding explicit statements of the level of ordinary skill is addressed at MPEP 2141.03(II): SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL. If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. Chore-Time Equip., Inc. v. Cumberland Corp., 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also Okajima v. Bourdeau, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

Thus, it is the position of the Office that an examiner is only required to make a statement on the record as to the level of ordinary skill when the level of ordinary skill is at issue in the case and is not adequately reflected in the record. Evidence of the level of ordinary skill will most often be

found in the prior art of record, but other documents that are part of the application file may also be relevant. This position is adequately supported in case law. "We hold only that an invention may be held to have been either obvious (or nonobvious) without a specific finding of a particular level of skill or the reception of expert testimony on the level of skill where, as here, the prior art itself reflects an appropriate level and a need for such expert testimony has not been shown." Chore-Time Equip., Inc. v. Cumberland Corp., 713 F.2d 774, 779 n.2 (Fed. Cir. 1983). "Although the Board did not make a specific finding on skill level, it did conclude that the level of ordinary skill in the art of asbestos removal and contamination control was best determined by appeal to the references of record . . . ." In re GPAC Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995). "Judge Pfaelzer discussed various factors involved in determining ordinary skill in the art, but did not specify a particular level applicable here. Nor need she have done so, for the parties are in agreement that their respective chemical expert witnesses with extensive backgrounds in sulfur chemistry are persons of ordinary skill in the art." Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 697 (Fed. Cir. 1983). A recent non-precedential case also supports the position of the Office: "[I]t is well-established that in certain situations, such as with relatively simple and understandable technology, a specific finding on the level of ordinary skill in the art is unnecessary because the prior art itself is representative of the relevant level of ordinary skill." Printguard, Inc. v. Anti-Marking Systems, Inc., 2008 WL 245415, at *11 (D. Mass. 2008) (citing Chore-Time at 779 & n.2).

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Ricciardi et al. (PGPub No. 20020059126) – teaches a novel system and

  method for generating investment signals for investment items in a given set

  of investment items is described herein. One aspect of the present invention

  involves defining a set of rules that generate investment signals such as to

  "buy" or "sell". These investment signals can be further scored with respect to

  a time period. Additional aspects of the present invention include further

  analyzing scoring the investment signals with the investment item's past price

  behavior and/or capitalization. Investment items identified in accordance with

  the present invention can be compared with other investment item scores and

  a portfolio may also be generated. These investment items may then be

  displayed in a manner helpful to the investment trader.

- Kauffman (US Patent No. 20010032029) – teaches bundling complementary

  products (a portfolio) which are needed to produce a finished product.

  Bundling with the automated market 108 can be thought of as a portfolio trade

  within the process. For certain exchanges, the automated market performs

  pooling of suppliers to satisfy one large purchaser. For example, the

  automated market will perform pooling of suppliers to satisfy one large

  purchaser in the graded diamond exchange.

- Hartnett (US Patent No. 6112188) – teaches tools and methods useful for

  privatizing, or transferring from state ownership to individual ownership, large

  state enterprises in newly democratic nations (including generation of

  portfolios based on stock correlation).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gregory Pollock whose telephone number is 571

270-1465. The examiner can normally be reached on 7:30 AM - 4 PM, Mon-Fri

Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chuck Kyle can be reached on 571 272-5233. The fax phone

number for the organization where this application or proceeding is assigned is

571-273-8300.

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direct.uspto.gov. Should you have questions on access to the Private PAIR

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Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

GAP

06/05/2009

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